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Attorney Docket No. 2950.25US02

SUPPLEMENTAL REPLY BRIEF TRANSMITTAL

In re the application of:

Reitz et al.

Confirmation No.: 2243

Application No.: 09/433,202

Examiner: M. A. Marcheschi

Filed: November 4, 1999

Group Art Unit: 1755

For: PARTICLE DISPERSIONS

Appeal Number: 2002-0227

Mail Stop Appeal Brief - Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Transmitted herewith, in triplicate, is the Supplemental Reply Brief in the above-identified application, with respect to the Supplemental Examiner's Answer dated July 9, 2003.

Respectfully submitted,

Peter S. Dardi, Ph.D.  
Registration No. 39,650

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PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

in the application of:

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Sir:

This is a Supplemental Reply Brief under 37 C.F.R. §1.193(b)(1) in response to the Supplemental Examiner's Answer mailed July 9, 2003. The Board of Patent Appeal and Interferences remanded the case to the Examiner in a decision reported on June 24, 2003 for the limited purpose of obtaining the Examiner's position on four separate and distinct obviousness-type double patenting rejections.

In response to the remand, the Examiner repeated the text from the original Examiner's Answer of May 4, 2001 with a few modifications to address the obviousness-type double patenting issues. This supplemental Reply Brief will be limited to addressing the Examiner's modified comments upon remand.

Double Patenting Rejection Over Copending Application 09/085,514

The Examiner rejected claims 1-32 for obviousness-type double patenting over claims 9-15 of copending application 09/085,514 in view of the Ishitobi patent and the Farkas patent. In view of the Terminal Disclaimer filed on February 26, 2001, this rejection has been withdrawn. See page 9, third full paragraph of the Examiner's Supplemental Answer.

Double Patenting Rejection Over Copending Application 09/136,483

The Examiner rejected claims 1-32 for obvious-type double patenting over claims 9-15 of copending application 09/136,483 in view of the Ishitobi patent and the Farkas patent. In view of the Terminal Disclaimer filed on February 26, 2001, this rejection has been withdrawn. See page 9, third full paragraph of the Examiner's Supplemental Answer.

Double Patenting Rejection Over Copending Application 09/266,202 and U.S. Patent 6,290,735

The Examiner rejected claims 1-32 under the judicial doctrine of obviousness-type double patenting over either (1) all issued claims of U.S. Patent 6,290,735 in view of the Ishitobi patent and the Farkas patent or (2) all of the pending claims of copending application 09/266,202 in view of the Ishitobi patent and the Farkas patent. In response to the present remand, the Examiner has indicated that even though the particle size distributions are not "**literally defined**, the claims define distributions which broadly read on the claimed distributions." Supplemental Examiner's Answer, page 9 (emphasis in original). Also, the Examiner has deemed it obvious to make a slurry although the cited copending applications do not recite particle dispersions. Applicants respond to the arguments in the following.

Prima facie obviousness is not established if all the elements of the rejected claim are not disclosed or suggested in the cited art. In re Ochiai, 37 USPQ 1127, 1131 (Fed. Cir. 1995). ("The test for obviousness *vel non* is statutory. It requires that one compare the claim's 'subject matter as a whole' with the prior art 'to which said subject matter pertains.'"). See also, MPEP 2143.03 "All Claim Limitations Must Be Taught or Suggested," citing In re Royka, 180

USPQ 580 (CCPA 1974). "To establish prima facie obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art." MPEP 2143.03.

To establish prima facie obviousness, all the elements of the claim must be taught or suggested by the cited references without the benefit of hindsight based on the applicant's own disclosure. "To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to **the insidious effect of a hindsight syndrome** wherein that which only the inventor taught is used against its teacher." W. L. Gore & Assocs., Inc. v. Garlock, Inc., 220 USPQ 303, 312-13 (Fed. Cir. 1983). "**Skill in the art does not act as a bridge over gaps in the substantive presentation of an obviousness case, but instead supplies the primary guarantee of objectivity in the process.**" All-Site Corp. v. VSI International Inc., 50 USPQ2d 1161, 1171 (Fed. Cir. 1999)(emphasis added).

The importance of the principle that the prior art itself must suggest the motivation to modify the teachings of a reference was eloquently stated in In re Rouffet, 47 USPQ2d 1453, 1458 (Fed. Cir. 1998)(emphasis added):

The Board did not, however, explain what specific understanding or technical principle within the knowledge of one of ordinary skill in the art would have suggested the combination. **Instead the board merely invoked the high level of skill in the field of the art. If such a rote invocation could suffice to supply a motivation to combine, the more sophisticated scientific fields would rarely, if ever, experience a patentable technical advance.** Instead, in complex scientific fields, the Board could routinely identify the prior art elements in an application, invoke the lofty level of skill, and rest its case for rejection. **To counter this potential weakness in the obviousness construct, the suggestion to combine requirement stands as a critical safeguard against hindsight analysis and rote application of the legal test for obviousness.**

It is long established that a composition of matter is indistinguishable from its properties. In re Papesch, 137 USPQ 43, 51 (CCPA 1963); In re Cescon, 177 USPQ 264, 266 (CCPA 1973). There are two types of properties, chemical/compositional properties and physical properties. The chemical/compositional properties of the composition of matter determine what the material is, while the physical properties relate to the interaction and behavior of the composition of matter. Often unique or unexpected physical properties are used to establish the existence of an

unobvious composition when chemical/compositional properties either are unknown or do not fully represent the unobviousness of the composition. However, discovery of a surprising or unexpected physical property does not necessarily control an obviousness determination, and all the evidence under the Graham factors must be considered. See, for example, Richardson-Vicks v. Upjohn Co., 44 USPQ2d 1181, 1187 (Fed. Cir. 1997).

To support an obviousness-type double patenting rejection, the present claims must be obvious over the claims of the corresponding primary reference when viewed in light of the secondary references.

With respect to U.S. Patent 6,290,735, the patent claims simply do not teach the particle size distributions of the present claims. The Examiners' statement that the claims of the '735 patent "define a distribution that broadly read on the claimed distributions" are not on point. The presently claimed distributions are narrower than the distributions of the '735 patent. It is well established that narrower claims can be patentable over broader earlier claims or there would almost never be any patentable improvements. The Examiner has simply provided no basis for supporting the obviousness-type double patenting rejection. With respect to present claim 31, the claims of the '735 patent do not relate to polishing rates at all. Furthermore, if this rejection were supported, there should be a prior art rejection under section 103(a) since the present application was filed before the amendment of 103(c) to include prior art under 102(e). The Examiner has failed to establish prima facie obviousness of the present claims over the claims of the '735 patent in view of the Ishitobi patent and the Farkas patent.

With respect to copending application 09/266,202, the claims of this patent are not directed to particle dispersions. The Examiner asserts without support that the dispersion aspect is obvious if it was desired to make a slurry, i.e., for polishing. However, the Examiner has not provided support for the proposition that zinc oxide had been recognized as being useful for polishing what other motivation there would be for forming a slurry for the particles in the claims of the '202 application. Furthermore, the Ishitobi patent and the Farkas patent do not teach or suggest

zinc oxide for polishing. Thus, the Examiner has not asserted a prima facie case of obviousness-type double patenting.

CONCLUSIONS AND REQUEST FOR RELIEF

Applicants submit that claims 1-28 and 31 are unobvious over the prior art of record. Applicants believe that the Examiner has failed to establish prima facie unpatentability of any of the claims including with respect to the remaining obviousness-type double patenting rejections. Thus, Applicants respectfully request the reversal of the rejections of claims 1-28 and 31 and the allowance of claims 1-28 and 31.

Respectfully submitted,



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